

## REMARKS

This correspondence is filed in response to the Office Action dated October 22, 2009. Claims 7, 9-13, 66-78 and 131-143 are currently withdrawn from consideration, and Claims 2-6 and 8 are pending but rejected under 35 U.S.C. § 103(a) as being unpatentable over Rice et al., US 7,330,585 (the '585 patent).

As is discussed in greater detail below, Applicants respectfully submit that the Office Action fails to articulate and prove a *prima facie* case of obviousness. Applicants further cite the Office Action's failure to provide proper weight to all recitation in the claims as is required under the M.P.E.P. and requirements set forth by the Federal Circuit. Finally, and importantly, Applicants respectfully submit that the cited reference does not teach or suggest each and every element of the claims, such as, for example, generating and displaying a three-dimensional graphical representation of the environs and at least one purchasable item selected by a customer. In this regard, the Official Notice cited in the Office Action is irrelevant and does not address the above claim language regarding generation and three-dimensional display. For at least these reasons, as further articulated below, Applicants respectfully request reconsideration and allowance of all pending claims of the application.

### **I. The Office Action Fails to Establish a *Prima Facie* Case of Obviousness under 35 U.S.C. § 103(a)**

The Office Action fails to comply with M.P.E.P. § 2142 and directives from the Federal Circuit regarding establishment of *prima facie* case of obviousness. Specifically, the Office Action fails to clearly articulate the reasons the claims are obvious with sufficient specificity to allow Applicants to ascertain and understand the rationales for the rejections, much less lodge a proper response thereto. Absent establishment of a *prima facie* case by the Office Action, the burden of proof regarding patentability has not shifted to Applicants. Section 2142 states:

The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in *KSR* noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit. M.P.E.P. §§ 2131(III), 2143. The Court quoting *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006), stated that "[R]ejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *KSR*, 550 U.S. at \_\_\_, 82 USPQ2d at 1396.

M.P.E.P. § 2142 (*emphasis added*). Furthermore, as M.P.E.P. § 2131 requires::

"Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art." M.P.E.P. § 2131(III). M.P.E.P. 2143.01(IV) is clear that a mere statement that "the claimed invention would have been 'well within the ordinary skill of the art at the time the claimed invention was made' ... is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teaching of the references."

The Examiner has not carried this burden, because no explanation has been given regarding why the claimed invention is obvious. Nor has any explanation been given concerning the differences between the claimed recitations and the prior art.

The Office Action includes only two sentences explaining application of the prior art to the claims. Indeed, there is no discussion of each and every element of the independent claims, and there is no discussion whatsoever regarding the dependent claims. And, as discussed later below, one of the two sentences of the rejection against the claims articulates taking of Official Notice of information that is not even relevant to the recitations of the claims.

Failure of the Office Action to clearly articulate the reasons for the rejection and provide proper guidance regarding application prior art to the claims means that a *prima facie* case of obviousness has not been established. Thus, the burden of proof of patentability has not shifted to Applicants. Frankly, it is very difficult for Applicants to

evaluate the rejections, much less lodge a proper response. For this reason alone, the rejections should be rescinded and either a new Office Action should be issued or the claims allowed.

## **II. The Office Action Fails to Follow the Procedures Outlined in the M.P.E.P. in Interpreting the Claims Thereby Creating a Technical Legal Error**

The Office Action alleges that the claims include intended use language “that is not given as much patentable weight as positively recited claim language.” Applicants respectfully submit that the Office Action is using a standard to differentiate weight given to different claim recitations that has no basis in patent law. There are no rulings, rules, procedures, etc. to Applicants counsel’s knowledge supporting the Office Action’s position. Indeed, the Office Action’s position is inapposite to what is expressly required by the M.P.E.P. and the Federal Circuit.

M.P.E.P. § 2173.05(g) specifically states that functional limitations must be considered just as any other limitation within a claim as shown by the following excerpt:

A functional limitation is an attempt to define something by what it does, rather than by what it is (e.g., as evidenced by its specific structure or specific ingredients). There is nothing inherently wrong with defining some part of an invention in functional terms. Functional language does not, in and of itself render a claim improper. ...

**A functional limitation must be evaluated and considered, just like any other limitation of the claim,** for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used. A functional limitation is often used in association with an element, ingredient, or step or a process to define a particular capability or purpose that is served by the recited element, ingredient or step. . . .

. . . .

In a claim that was directed to a kit of component parts capable of being assembled, the Court held that limitations such as "members adapted to be positioned" and "portions . . . being resiliently dilatable whereby said housing may be slidably positioned" serve to precisely define present structural attributes of interrelated component parts of the claimed assembly. (emphasis added) (citing *In re Barr*, 444 F.2d 588 (C.C.P.A. 1971)).

As prescribed explicitly in the M.P.E.P., all of Applicants' claimed limitations, regardless of their structural or functional nature, must be examined with even weight. The M.P.E.P. section clearly states: "**A functional limitation must be evaluated and considered, just like any other limitation of the claim.**" The Examiner in this case has failed to do so, and as such, has produced a technical legal error. This error in examination cannot support the obviousness rejection of Applicants' claims, and therefore, Applicants' respectfully request the rejection be withdrawn.

### **III. The Claims Are Patentable**

At a minimum, the '585 patent does not teach or suggest receiving data representing an environs and generating and displaying a three-dimensional graphical representation of the environs and at least one purchasable item selected by a customer so that the customer can visualize the item in the environs.<sup>1</sup> Nowhere does the '585 patent disclose or suggest these limitations. At best, the '585 patent only discloses two-dimensional display of items, not three-dimensional display. The specification of the present application provides a clear articulation of the difference between 2D and 3D display: "[o]nce the three-dimensional graphical representation is generated, the customer 20 can virtually walk through the environs and change or modify their selection of purchasable items as needed." (See para [0082]).

The Office Action appears to concede that the '585 patent does not disclose three-dimensional generation and display, as it does not attempt to apply the disclosure of the '585 patent to this recitation. Instead, the Office Action uses the procedure of taking Official Notice to provide a rejection of the three dimensional generation and display of environs and a purchasable item. However, what the Office Action states it is taking official notice of does not meet the claim recitations and demonstrates a misunderstanding of the recited claim language.

The Office Action takes official notice that "receiving data for a purchasable item and visualizing such by a customer having a preference has been common knowledge in the business

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<sup>1</sup> Applicants submit that other recitations of the claims are also not taught or suggested by the '585 patent. But, as the Office Action has failed to establish a *prima facie* case of obviousness, Applicants do not believe there is a need to articulate such differences absent further clarifications from the Examiner.

art.” The Office Action essentially states that it is known for a user to select a purchasable item and visualize the item in an environ. Whether this is true or not, it is not what the claims recite or refer to. The recitations of the claims do not require the customer alone to visualize the selected item in an environ. Instead, the claimed invention actually generates and displays the selected item three dimensionally in a three dimensional image of an environ. In short, the claimed invention eliminates the need for a customer to perform a visualizing step himself or herself by expressly displaying to the customer a three-dimensional display of the item in the environs. The official notice taken by the Office Action does not comport with the recitations of the claims.

#### **IV. Proposed Interview**

Applicants respectfully request an interview with the Examiner and his supervisor if the Examiner determines, after considering this Response, that the claims are not allowable. Dating back to the original Office Action, there has been little to no explanation of how the cited prior art applies against the claims in the rejections. Instead, contrary to express guidelines in the M.P.E.P. and by the Federal Circuit, only cursory, broad allegations have been made in each office action regarding patentability. Further, there is little or no attempt made to comment on examination of dependent claims; despite the express requirement that all claims in an application be examined and clear articulations of the reasons for rejection of each claim be provided in the Office Action. Further, a restriction requirement was untimely issued in a second Office Action against claims that were originally in the application and presumably examined in the first Office Action. An impermissible final rejection was issued where the claims were not amended but new prior art was cited against the claims. The final rejection was withdrawn, but not until after Applicants incurred the expense and burden of filing a Petition for Withdrawal of Finality and a Pre-Appeal Request for Review.

Applicants propose the interview with the Examiner and his supervisor (if the Examiner determines that the claims are not allowable after considering this Response) so that the merits of the claims can be discussed in a cordial and cooperative manner and in hopes of avoiding the issuance of any additional Office Actions that fail to comply with the express guidelines of the

M.P.E.P. and Federal Circuit law. Office Actions that fail to comply with the applicable guidelines and law create unnecessary burden and expense for Applicants and tend to waste the Examiner's time and resources. Such Office Actions do not advance prosecution and potentially create a need for appeals that otherwise could be avoided—yet another unnecessary burden on the resources of the U.S. Patent and Trademark Office. Applicants are very interested in advancing prosecution of the application and are looking prospectively forward to working with the Examiner and/or his supervisor to place the application in condition for allowance.

In summary, the Office Action has failed to establish a *prima facie* case of obviousness at least by failing to clearly articulate the reasoning behind the obviousness determination. Further, the '585 patent, by itself, or in combination with the Official Notice, does not teach or suggest all of the limitations of the claimed invention. Accordingly, reconsideration and allowance of Claim 6 are respectfully requested. Claims 2-5 and 8 depend from claim 6, and are patentable for at least the reasons discussed above regarding claim 6. Reconsideration and allowance of claims 2-5 and 8 are also respectfully requested.

### **Conclusion**

In view of the remarks presented above, it is respectfully submitted that all of the present claims of the application are in condition for immediate allowance. It is therefore respectfully requested that a Notice of Allowance be issued. The Examiner is encouraged to contact Applicants' undersigned attorney to resolve any remaining issues in order to expedite examination of the present application.

It is not believed that extensions of time or fees for net addition of claims are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 CFR § 1.136(a), and any fee required

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therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 13-4365.

Respectfully submitted,

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